

Application No.: 10/659877

Case No.: 58079US004

Remarks

Favorable consideration of this application in the light of the following discussion is respectfully requested. Claims 1-20 are pending in the application. The Patent Office has asserted a restriction requirement under 35 USC § 121 as follows:

I. Claims 1-16 and 18-20 were said to be drawn to a compound comprising a copolymer of one or more perfluorinated ethers of formula I and II, classified in Class 526, subclass 247;

II. Claim 17 was said to be drawn to a compound comprising a terpolymer of vinylidene fluoride with one or more perfluorinated ethers of formula I and II, classified in Class 526, subclass 255.

According to the Examiner, inventions I and II are unrelated. The Examiner noted that inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation or different functions.

In the instant case, the Examiner averred that the fluoropolymers made from Invention I and II, may each contain some repeating units from other invention. However, the Examiner stated that the individual property of monomers will not be shown in its polymers mainly due to tremendous differences in molecular weight. Although perfluorinated ethers of formula I and II are used in both cases, the Examiner stated that Invention I relates to a copolymer only made from perfluorinated ethers, while Invention II is restricted to use both vinylidene fluoride with perfluorinated ethers. Since they are two different copolymers, which may be from different polymerization and with different properties, the Examiner concluded that they are therefore different inventions.

With the presence of hydrogen atoms in the backbone, The Examiner averred that vinylidene fluoride-containing polymers behave different from perfluoropolymers in view of the structure and properties. Furthermore, The Examiner stated that the process of making is unique and thereby not interchangeable. Therefore, according to the Examiner, the scope of the claims, i.e., the metes and boundaries are distinct.

With respect to perfluorinated ethers, the Examiner stated that Formula I is quite different from Formula II in view of the structure and properties. In the case either Group I or Group II is

elected, the Examiner noted that Applicants need to further elect one of the following three species:

- Species (1) perfluorinated ethers from Formula I
- Species (2) perfluorinated ethers from Formula II
- Species (3) perfluorinated ethers from both Formula I and Formula II.

The Examiner concluded that restriction is proper because these inventions are distinct for the reasons given above shown as different subject matters and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification.

Applicants' Response to the Restriction under 35 U.S.C. 121

Applicants elect, with traverse, the invention of group I drawn to a compound comprising a copolymer of one or more perfluorinated ethers of formula I and II, and recited in claims 1-16 and 18-20. Applicants further elect Species (1) drawn to the perfluorinated ethers of Formula I.

Applicants respectfully traverse the restriction requirement. M.P.E.P. § 803 requires that the two conditions be met for a proper requirement for restriction between patentably distinct inventions. First, the inventions must be independent or distinct as claimed. Second, there must also be serious burden on the Examiner if restriction is not required (see M.P.E.P. §803.02; §806.04 (a)-(j); §808.01 (a); and §808.02).

Applicants submit the restriction between groups I and II is improper because the claims would not impose a serious burden on the Examiner if both groups were prosecuted under the same application. In support, applicants respectfully point out that both groups I and II represent fluorinated copolymers in the same class. The scope of analysis of novelty of all the claims of Groups I and II would have to be as rigorous as when only the claims of Group I were being considered by themselves. Clearly, this duplication of effort would not be warranted where these claims of different subclasses are so interrelated.

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Conclusion

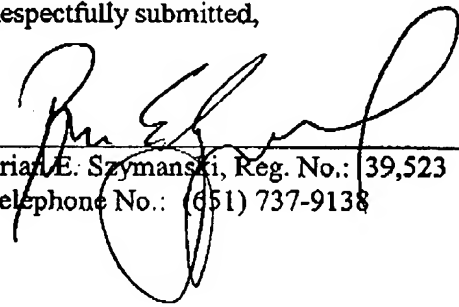
Applicants have elected Group I, comprising claims 1-16 and 18-20. Additionally, applicants have elected Species I drawn to the perfluorinated ethers of Formula I. Continued prosecution of this application is respectfully requested.

It is believed that no fee is due; however, in the event a fee is required, please charge the fee to Deposit Account No. 13-3723. The Examiner is invited to contact the undersigned at the indicated telephone number with questions that can be resolved with a simple teleconference.

Respectfully submitted,

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Date

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